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**OCT 02 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Tadayoshi Okada et al.	:	
Application No. 10/663,060	:	DECISION ON RENEWED PETITION
Filed: September 12, 2003	:	UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: A35998-	:	AND PETITIONS UNDER 37
074224.0118	:	C.F.R. §§1.137(B), 1.182,
Title: HIGH-STRENGTH BOLTED	:	AND 1.183
CONNECTION STRUCTURE WITH NO	:	
FIRE PROTECTION	:	

This is a decision on the renewed petition under 37 C.F.R. §1.181(a), filed September 1, 2006, to withdraw the holding of abandonment, along with the concurrently filed petitions under 37 C.F.R. §§1.137(b), 1.182, and 1.183.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. §1.113 in a timely manner to the final Office action mailed June 24, 2005, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 25, 2005. A notice of abandonment was mailed on August 15, 2006.

The original petition under 37 C.F.R. §1.181(a) was submitted on January 11, 2006, and was dismissed via the mailing of a decision on March 16, 2006. The renewed petition under 37 C.F.R. §1.181(a) was submitted on June 16, 2006 and was dismissed via the mailing of a decision on July 17, 2006.

RELEVANT STATUTE AND PORTIONS OF THE C.F.R.

35 U.S.C. §133 sets forth, in toto:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. §1.8(b) sets forth, in toto:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

37 C.F.R. §1.134 sets forth, in toto:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

37 C.F.R. §1.137(b) sets forth, *in toto*:

(b) Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 C.F.R. §1.182 sets forth, *in toto*:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

### ANALYSIS

#### The petition under 37 C.F.R. §1.181(a):

With the original petition under 37 C.F.R. §1.181(a), Petitioner asserted that on October 19, 2005, a response to the final Office action was timely submitted in conjunction with a one-month extension of time via facsimile transmission. Petitioner supplied a copy of this response with the original petition, and the response contained a certificate of facsimile transmission dated October 19, 2005. This response was considered by the Examiner, and it was determined by the same that it failed to place the application in condition for allowance. As such, the petition was dismissed via the mailing of a decision on March 16, 2006. An advisory action was included with this decision, indicating that the response which was submitted on January 11, 2006<sup>1</sup> failed to place this application in condition for allowance.

With the renewed petition under 37 C.F.R. §1.181(a), Petitioner asserted that the advisory action "apparently does not concern the facsimile after-final response of October 19, 2005...the enclosed Advisory Action concerns Petitioner's RCE filing of January 9, 2006<sup>2</sup>." The petition was dismissed as Petitioner had previously attested, over his registration number, that the documents which were enclosed with the original petition were the same documents which were presented to the Office on October 19, 2005<sup>3</sup>. It was indicated that if the two submissions were identical, if the advisory action concerned one submission, then it must concern the other.

With the present second renewed petition, Petitioner asserts that the undersigned misunderstood Petitioner's "assertion that the advisory action concerning the RCE filing of January 11, 2006 and does not concern the previous identical-content After Final response of October 19, 2005<sup>4</sup>." Petitioner asserts "applicants respectively submit that should no misunderstanding that this and the previous petitions are directed to timing and

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1 Petitioner affirmatively represented that the response which was submitted with the petition on January 11, 2006 is a copy of that which was originally transmitted to the Office on October 19, 2005.

2 Renewed petition, page 2.

3 Original petition, page 2.

4 Second renewed petition, page 2.

the improper retroactive 'holding of abandonment,' and not to the technical content of applicant's two submissions<sup>5</sup>."

The meaning of this sentence cannot be ascertained by the undersigned. Perhaps Petitioner is asserting that it was improper for the Office to review the after-final amendment of October 19, 2005 upon receipt of the same with the original petition of January 11, 2006? If this is Petitioner's intent, Petitioner will note that it was not possible to review the amendment of October 19, 2005 on that date, as it was not received in the office until January 11, 2006. Petitioner will further note that the timing of the review of the after-final amendment is wholly independent of the validity of the reasoning contained therein.

The timeline of the significant events is as follows:

- June 24, 2005: mailing of the final Office action
- October 19, 2005: After-final amendment and one-month extension of time are submitted to the Office (submission is not received, but bears a certificate of facsimile transmission)
- December 24, 2005: six month anniversary of the mailing of the final Office action
- January 11, 2006: RCE is filed.
- March 6, 2006: Advisory Action is mailed, indicating that the amendment filed January 11, 2005 (which is the same amendment which was submitted on October 19, 2005 but not received by the Office) fails to place the application in condition for allowance.

Petitioner has asserted that since at the time of the filing of the RCE, there was no indication by the Office that the amendment of October 19, 2005 was either not acceptable or failed to place the application in condition for allowance. As such, the filing of the "Jan 11, 2006 RCE was timely<sup>6</sup>." Therefore, the holding of abandonment should be withdrawn and the RCE should be processed.

Petitioner is incorrect - the RCE was not timely filed. The RCE was filed on January 11, 2006, which is subsequent to the six month anniversary of the mailing of the final rejection. The final rejection was mailed on June 24, 2005. Petitioner will note the indication on the final rejection which clearly states

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<sup>5</sup> Id.

<sup>6</sup> Id.

"in no event, however, may a reply be timely filed after SIX (6) MONTHS (emphasis included) from the mailing date of this communication."

Petitioner is reminded that pursuant to 35 U.S.C. §133 and 37 C.F.R. §1.134, the Office has no authority to enter a paper subsequent to the expiration of the six-month period for response.

As set forth in the decision on the renewed petition:

It is clear from rules 37 C.F.R. §§1.116 and 1.135 that abandonment of an application is risked when the applicant proffers an amendment after the mailing of a final Office action. The rule clearly indicates that the mere filing of an amendment does not relieve applicant of the duty to take appropriate action to save the application from abandonment.

If steps are not taken after final to maintain pendency prior to the expiration of the maximum extendable period for reply, the application will go abandoned. Put another way, the submission of an after final amendment which fails to place the application in condition for allowance will result in the abandonment of the application, unless one of the following four items is filed prior to the maximum extendable period for reply:

- a subsequent amendment which places the application in condition for allowance;
- a Notice of Appeal;
- a Request for a Continuation Application pursuant to 37 C.F.R. § 1.53(b), if applicable;
- a Request for Continued Examination pursuant to 37 C.F.R. §1.114, and;
- a Terminal Disclaimer, if applicable.

Petitioner received a final Office action, and submitted an after-final response, which failed to place the application in condition for allowance. Petitioner will note that had the after-final amendment placed the application in condition for allowance, consisted of a notice of appeal, or consisted of an RCE, the previous petition would have been granted, and the holding of abandonment would have been withdrawn. But such is not the case - Petitioner submitted an after-final amendment which failed to place the claims in condition for allowance. As such, the after-final amendment, even if it had been received and processed when it was originally submitted, could not have been accepted, and the present application would have gone abandoned.

Petitioner is effectively requesting that the Office accept the RCE, which was filed with the original petition, and treat the same as if it had been submitted along with the after-final amendment which failed to place the application in condition for allowance. This cannot be done, as the Office has no authority to accept a response as timely filed if filed after the maximum extendable period for reply (emphasis added).

Petitioner has further asserted that the advisory action "appears to be hurried and without proper examination<sup>7</sup>." Petitioner's negative assessment of the advisory action is not well taken. Petitioner submitted an after-final amendment which failed to place the application in condition for allowance, and was informed of the same. Petitioner adds that the advisory action is "perfunctory: it merely states that for 'purposes of appeal, the proposed amendments will be entered' but fails to append 'an explanation of how the new or amended claims would be rejected.' (See Advisory Action, Item #7)<sup>8</sup>."

It is noted that it does not appear that Petitioner has cited to any authority which requires the Examiner to append an explanation as to how the new or amended claims would be rejected. Petitioner will note that item number seven reads "for purposes of appeal, the proposed amendment(s)...will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended (emphasis added)." Below this portion, the Examiner provided the following: "claim(s) rejected: 10-18."

Petitioner received a non-final Office action and a final Office action before submitting his after-final amendment. It appears that in lieu of an advisory action, Petitioner would have preferred a third Office action explaining the rationale for the rejection of the after-final amendment. It is noted that Petitioner has cited to no authority which would require the Examiner to provide any review of the after-final amendment which is more substantial than that which was provided to him via the Advisory Action of March 16, 2006, other than to merely characterize the advisory action as "perfunctory," "improper," and "unfair<sup>9</sup>."

Petitioner failed to submit the RCE until after the expiration of the maximum extendable period of response. Petitioner timely submitted an after-final amendment, however this amendment failed to place the application in condition for allowance. As such, the Examiner properly issued an advisory action, indicating the same. There does not appear to be any reason why the holding of abandonment should be withdrawn. It follows that the second renewed petition under 37 C.F.R. §1.181 must again be **DISMISED**.

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7 Second Renewed Petition, page 2.

8 Second Renewed Petition, pages 2-3.

9 Second Renewed Petition, page 3.

The petition under 37 C.F.R. §1.182:

The \$400 fee associated with the filing of this petition has been charged to Petitioner's Deposit Account, as authorized in the petition.

Petitioner has set forth that a petition under Rule §1.182 is appropriate, "because the rules do not provide for situations like here having 'a retroactive determination' and a 'perfunctory Advisory Action'<sup>10</sup>."

The rules clearly provide for the situation which Petitioner has found himself presented with. Petitioner received a final Office action, and in lieu of submitting his RCE in a timely manner, instead chose to submit another amendment. As set forth above, it is clear from rules 37 C.F.R. §§1.116 and 1.135 that abandonment of an application is risked when the applicant proffers an amendment after the mailing of a final Office action, Petitioner's dismissal of the Examiner's review as "retroactive" and his dismissal of the Examiner's work product as "perfunctory" notwithstanding.

It follows that the petition under 37 C.F.R. §1.182 must be **DISMISSED**.

The petition under 37 C.F.R. §1.183:

The \$400 fee associated with the filing of this petition has been charged to Petitioner's Deposit Account, as authorized in the petition.

Petitioner has requested the waiver of rules 37 C.F.R. §§1.113, 1.114, "1.117 petition fees," and 1.136 extension of time fees.

Regarding the request to waive 37 C.F.R. §1.114, it is not clear what portion of the rule he wishes to have waived.

Regarding the request to waive 37 C.F.R. §1.117, it is noted that there is no Rule §1.117. Rule §1.117 has been reserved. As such, there is nothing to waive.

Regarding the request to waive 37 C.F.R. §1.136, Petitioner will note that an extension of time under 37 C.F.R. §1.136 must be filed prior to the expiration of the maximum extendable period

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<sup>10</sup> Second Renewed Petition, page 3.



for reply<sup>11</sup>. Accordingly, no extensions of time are required or possible, as the maximum extendable period for reply has already passed. As such, the rule is inapplicable.

A discussion on the request to waive 37 C.F.R. §§1.113 follows. 37 C.F.R. §1.113 sets forth, *in toto*:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Petitioner seeks the waiver of this rule so that finality can be lifted on the Office Action of June 24, 2005.

In order to submit a grantable petition under 37 C.F.R. 1.183, a petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not established that either condition exists in this case.

The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. Applicant received a non-final Office action on January 14, 2005, and submitted an amendment on April

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<sup>11</sup> See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

18, 2005. The amendment was considered by the Examiner, and was not deemed to place the application in condition for allowance. Consequently, the rejection of this amendment was made final. 37 C.F.R. §1.113, the rule which Petitioner seeks the waiver of, sets forth that on the second examination, the rejection may be made final. There does not appear to be anything extraordinary about a situation where on second examination, the rejection was made final.

Petitioner has provided no explanation as to what makes his situation extraordinary, other than to merely assert the same.

Furthermore, since the PTO did not cause or contribute to Petitioner's failure to provide allowable claims in the amendment provided after receiving the non-final Office action, this case is even further removed from consideration as one where "justice requires" equitable relief<sup>12</sup>. In the final rejection, the Examiner concluded that Petitioner's claims were unpatentable over a particular patent. Petitioner then submitted an amendment containing claims which were not deemed to be distinguishable over the prior art: this is not an "extraordinary situation" where "justice requires" an extraordinary remedy.

It follows that Petitioner's circumstances are not extraordinary, and justice fails to require waiver of Rule §1.113.

The petition under 37 C.F.R. §1.183 is **DISMISSED**.

The petition under 37 C.F.R. §1.137(b):

A grantable petition pursuant to 37 C.F.R. 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;

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<sup>12</sup> See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

- (4) Any terminal disclaimer (and fee as set forth in §1.20(d)).

The \$1500 fee associated with the filing of this petition has been charged to Petitioner's Deposit Account, as authorized in the petition.

With the present petition, Petitioner has submitted the petition fee and the proper statement of unintentional delay. Petitioner has previously submitted a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 and the associated fee.

No terminal disclaimer is required. The RCE has been accepted as the required reply under 37 C.F.R. §1.137(b)(1). The previously submitted amendment shall serve as the required submission.

As such, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment of May 30, 2006 can be processed.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>13</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski  
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United States Patent and Trademark Office

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<sup>13</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).